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**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

Paper No. 11  
EJS

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

In re Quicklaw America, Inc.,  
by change of name from  
Current Legal Resources, Inc.<sup>1</sup>

Serial No. 75/521,756

Stuart Lewine, Vice President of Quicklaw America Inc. and  
Legal Content Inc., pro se.

Tina L. Snapp, Trademark Examining Attorney, Law Office 105  
(Thomas G. Howell, Managing Attorney).

Before Seeherman, Hohein and Rogers, Administrative  
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Quicklaw America Inc., by change of name from Current  
Legal Resources, Inc., has appealed the final refusal to  
register UNITED STATES CODE ONLINE for "providing the  
updated and editorially enhanced text of the U.S. Code in

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<sup>1</sup> With its communication filed February 2, 2001, applicant has  
advised the Office that its mark "has been transferred" to Legal  
Content Inc. If applicant wishes any resulting registration to  
issue in that name, it must record the assignment or other  
transfer document with the U.S. Patent and Trademark Office.

an on-line format, via a global computer network."<sup>2</sup>  
Registration has been refused pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that the mark is merely descriptive of applicant's services, and pursuant to Section 2(d) of the Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark UNITED STATES CODE ANNOTATED, previously registered for a "series of annotated books and pamphlets dealing with the Constitution of the U.S. and the General and Permanent Statutory Laws of the U.S.,"<sup>3</sup> as to be likely, when used in connection with applicant's identified services, to cause confusion or mistake or to deceive.

Applicant and the Examining Attorney have submitted briefs, but an oral hearing was not requested.

We turn first to the refusal based on Section 2(e)(1). A mark is merely descriptive, and therefore prohibited from registration by Section 2(e)(1) of the Act, if it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of a product or service. It does not have to describe

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<sup>2</sup> Application Serial No. 75/521,756, filed July 20, 1998. The application was filed based on a bona fide intention to the use the mark; on September 14, 1998 applicant filed an amendment to allege use asserting first use dates of August 5, 1998.

<sup>3</sup> Registration No. 1,232,666, issued March 29, 1983; Section 8 affidavit accepted; Section 15 affidavit received.

every one of these. It is sufficient if it describes a single, significant quality, feature, function, etc. **In re Venture Lending Associates**, 226 USPQ 285, 286 (TTAB 1985). See also **In re H.U.D.D.L.E.**, 216 USPQ 358 (TTAB 1982); **In re MBAssociates**, 180 USPQ 338 (TTAB 1973).

Applicant's services are identified as "providing the updated and editorially enhanced text of the U.S. Code in an on-line format, via a global computer network." The identification and specimens make clear that applicant provides, in an on-line format, the text of the United States Code. The term UNITED STATES CODE names the subject matter of applicant's services. As applicant has pointed out, "United States Code" is the statutory name given to the compilation of laws of the United States. As applicant has acknowledged, the term UNITED STATES CODE "is merely descriptive; it merely indicates that the relevant goods or services involve a presentation of the federal government's official arrangement of federal laws, which arrangement is officially named by statute as the 'United States Code'." Brief, p. 4. The word ONLINE also has a readily understood meaning, as the identification shows. When the words are combined in the mark UNITED STATES CODE ONLINE and used in connection with the identified services, it immediately and directly conveys information about the subject matter

presented by applicant, and the mode by which it is provided.

Applicant asserts that its mark is not merely descriptive because it does not make the United States Code available on line as a "static and linear body of text," but updates its presentation on a daily basis, provides a method of performing various types of searches, and a system of hyperlinks enabling a user to jump directly from one place in the text to a related place. Brief, p. 5. However, as noted above, it is not necessary that a term describe each of the characteristics of an applicant's services in order to be found merely descriptive. In this case, the mark describes an essential characteristic of applicant's on-line services, namely, that the subject matter includes, and indeed focuses on, the United States Code. As such, it is merely descriptive of applicant's services. The fact that the mark does not also describe the various enhancements by which a consumer may search the United States Code does not avoid such a finding.

Nor are we persuaded by applicant's argument that the juxtaposition of UNITED STATES CODE and ONLINE in the mark has an incongruous meaning because the United States Code originally existed only in a print format. It is common knowledge that many reference materials that once were

found only in paper form are now available through computer networks. For example, in the legal research area (the area in which many of applicant's consumers would practice), law reports which were previously available through book series are now available on-line and through computer data bases, through such services and products as LEXIS and BNA's Intellectual Property Library on CD. Such consumers will not see any incongruity in the mark UNITED STATES CODE ONLINE; they will immediately recognize that the United States Code is being presented in an on-line version, just like many other legal volumes. Applicant's reliance on **In re TBG Inc.**, 229 USPQ 759 (TTAB 1986) (SHOWROOM ONLINE found not merely descriptive) is misplaced; as explained in **In re Putman Publishing Co.**, 39 USPQ2d 2021 (TTAB 1996), SHOWROOM was suggestive for that applicant's services because the applicant did not sell or lease interior furnishings, or otherwise offer through its computer database leasing service materials akin to that offered by a showroom. The present case is more akin to Putnam, in which FOOD & BEVERAGE ON-LINE was found to be merely descriptive of "a news and information service updated daily for the food processing industry, contained in a database." Just as in Putnam, applicant's mark

describes the subject matter it presents and the method by which it presents it.

Accordingly, the refusal of registration on the ground that the mark is merely descriptive of the identified services is affirmed.

This brings us to the refusal on the ground that UNITED STATES CODE ONLINE for "providing the updated and editorially enhanced text of the U.S. Code in an on-line format, via a global computer network" is likely to cause confusion with UNITED STATES CODE ANNOTATED for "series of annotated books and pamphlets dealing with the Constitution of the U.S. and the General and Permanent Statutory Laws of the U.S." In making our determination as to whether there is a likelihood of confusion, we must consider all relevant factors as set forth in **In re E. I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Each of the factors may from case to case play a dominant role.

**Kellogg Company v. Pack'em Enterprises, Inc.**, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

In this case, three of the most important factors are the similarities of the marks, the strength of the registered mark, and the sophistication of the purchasers of applicant's services and the registrant's goods.

As noted above, the term "United States Code" is the term used by statute to refer to the laws of the United States, and is not entitled to exclusive appropriation by anyone. Therefore, we do not accept the Examining Attorney's assertion that these words are the dominant part of each mark. On the contrary, a determination of likelihood of confusion cannot be based simply on the fact that this term is common to both applicant's and the registrant's marks. The remaining portions of the marks, ANNOTATED and ONLINE, are different in appearance, pronunciation and connotation. Although the words are descriptive of the respective goods and services, they are descriptive of different facets of the goods and services.

Normally, of course, marks would not be distinguishable based on their descriptive elements. Here, however, we are presented with a situation in which each of the marks at issue is made up of descriptive words. The cited mark was registered pursuant to the provisions of Section 2(f), a recognition that UNITED STATES CODE ANNOTATED was originally considered to be merely descriptive, and was registered only upon the Examining Attorney's finding that it had acquired distinctiveness. Nevertheless, we cannot, in the absence of any evidence to

that effect,<sup>4</sup> treat the cited mark as a strong mark which is entitled to a wide scope of protection against any mark which contains the words UNITED STATES CODE.

It must also be remembered that the likely consumers of the registrant's goods and applicant's services are those who wish to do legal research. These consumers must be considered careful as well as sophisticated. They will be familiar with the United States Code, and will not assume a common source even for related goods and services<sup>5</sup> simply because both marks contain this term. Rather, they will look to the other elements in the marks. These additional elements, even though descriptive, are different, and these differences are sufficient, given the weaknesses of both marks, to avoid confusion. We would

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<sup>4</sup> The Examining Attorney states that the fame of the registered mark is one of the relevant factors and implies, with her statement that "the other factors cannot be considered because no relevant evidence concerning those factors is contained in the record," brief, p.3, that there is evidence on the factor of fame. However, no such evidence has been submitted.

<sup>5</sup> The Examining Attorney asserts in her brief that both applicant and the registrant are "offering the relevant services on-line." Although the Examining Attorney has submitted copies of other registrations owned by the registrant for computerized legal research services, the cited registration is for goods, i.e., a series of annotated books and pamphlets, and there is no indication that registrant offers any computerized or on-line research services under the cited mark. While we do not dispute that applicant's goods and the registrant's services are related in view of their similar subject matter and class of consumers, much of the Examining Attorney's arguments relating to the channels of trade, marketing practices, and so on, appear to be based on the notion that the cited registration is for services.

also point out, in view of the cases cited in the Examining Attorney's brief, that this is not a situation in which applicant has appropriated the mark of the registrant in its entirety, and merely added descriptive wording to it. Instead, applicant has taken a phrase which is included in the registrant's mark but is not the mark in its entirety, a phrase, moreover, which is the official term for the subject matter of its service, and added to it a descriptive term which is different from that in the cited registration.

Accordingly, we find that applicant's use of UNITED STATES CODE ONLINE for its identified services is not likely to cause confusion with the cited registration for UNITED STATES CODE ANNOTATED.

Decision: The refusal based on Section 2(e)(1) of the Act is affirmed; the refusal based on Section 2(d) of the Act is reversed.